IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Attorney Docket No. 56490.000004
	)	
David VERCHERE	)	Confirmation No. 9529
	)	
Serial Number: 09/838,133	)	TC/A.U.: 3625
	)	Examiner: Yogesh C. Garg
Filed: April 20, 2001	)	
	)	Customer No. 21967

For: METHOD AND SYSTEM FOR CONFIGURATING PRODUCTS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF (37 CFR 41.37) AND SUBMISSION OF A SUPPLEMENTAL APPEAL BRIEF

Appellants hereby respond to the Notification of Non-Complaint Appeal Brief (37 CFR 41.37) mailed August 5, 2005, by submitting a Supplemental Appeal Brief filed concurrently herewith, in connection with the above-captioned patent application. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Notification of Non-Complaint Appeal Brief, Appellants have included "Appendix B - Evidence" and "Appendix C - Related Proceedings" and indicated that none exist.

Respectfully submitted,

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Dated: September 7, 2005

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SUPPLEMENTAL APPEAL BRIEF

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SUPPLEMENTAL APPEAL BRIEF

Appellant's Supplemental Appeal Brief in connection with the above-captioned patent application is hereby submitted. The requisite fee in accordance with 37 C.F.R. § 1.17(c) was submitted with the filing of the Appeal Brief, which was filed with the U.S. Patent and Trademark Office on June 14, 2005. A Notice of Appeal was submitted on March 14, 2005. It is respectfully submitted that this Supplemental Appeal Brief is timely filed. Each item required by 37 C.F.R. § 41.37 is set forth below. Appellant believes that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Office Action dated March 14, 2004, rejecting pending claims 1-5, 7-15 and 17-20, Appellant respectfully requests that the Board of Patent Appeals and Interferences reconsider and withdraw the rejection of record, and allow the pending claims, which are attached hereto as Appendix A.

I. REAL PARTY IN INTEREST

The real party in interest is Regency Ventures, LTD, the assignee of the above-referenced application.

II. RELATED APPEALS AND INTERFERENCES

The current patent application claims priority to U.S. Patent Application Serial No. 09/441,204 which is on appeal. An appeal brief was filed on January 10, 2005.

III. STATUS OF CLAIMS

Claims 1-5, 7-15 and 17-20 are pending in the application. The rejections of each of claims 1-5, 7-15 and 17-20 are appealed.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been filed subsequent to the rejection dated October 13, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Summary of the Invention

According to an embodiment of the present inventions, a system and method are directed to a computer implemented method and system for configurating one or more products where products may be divided into items and processes wherein item and process parameters may be separately specified and linked together to create a unique product where a product identifier may be dynamically created when the product is source, quoted, ordered or otherwise accessed (specification, page 1, lines 9-13).

The present invention may separate the item and process specification methods into various levels using templates, as shown in Figure 1. A user may access the method and system of the present invention by logging in to the system at 110. Standard item or process templates may be supplied through the present invention. A vendor administrator 112 (or other entity) may create item or process definition pages 114 based on the standard item or process templates 116. A vendor product manager 118 (or other entity) may enter the item or process specifications and pricing information 120 using the item or process definition pages 122. Items and processes may then be searched and matched based on materials or other specifications and stored in a database, at 124. A specific item template may be used in conjunction with several types of items with similar characteristics. Similarly, a specific process template may be used for several types of processes with similar characteristics or functions. (page 8, lines 1-12).

Another feature of the present invention includes a pricing algorithm. The pricing algorithm may depend on the item and associated processes chosen. In general, the pricing may be based on the item and process production specifications. The manufacturing specifications for a particular promotional product may not exist until an entity has specified item parameters, process parameters, a client's artwork parameters, and other specifications. According to another feature of the present invention, manufacturers may go online and update their own pricing anytime so distributors may know that the price they see is the correct and most recent price. The present invention may assist the user in assessing an accurate cost with extra charges, such as setup charges, run charges, and even shipping charges. (page 8, lines 12-20).

B. Embodiments of the Claimed Invention

As recited in independent claim 1, a computer implemented method includes the steps of receiving a request for a branded product from a user through an online interface (Figure 3);

separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified (Figure 3); applying a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price (pages 6-7, page 8, lines 12-20); linking the item parameters, the process parameters and the artwork parameters; creating a product identifier for the product (122, Figure 1); and branding the product as requested, wherein the product is identified by the product identifier.

As recited in independent claim 11 recites similar limitations, a computer implemented system for configurating one or more products comprising an online interface for receiving a request for a branded product from a user (Figure 3); separating means for separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified (Figure 3); a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price (pages 6-7, page 8, lines 12-20); linking means for linking the item parameters, the process parameters and the artwork parameters (122, Figure 1); creating means for creating a product identifier for the product; and branding means for branding the product as requested, wherein the product is identified by the product identifier.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are as follows.

A. Whether claims 1-5, 7-15 and 17-20 are unpatentable under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

B. Whether claims 1-5, 7-15 and 17-20 fail to comply with the written description requirement under 35 U.S.C. 112, first paragraph.

C. Whether claims 1-5, 7, 9-15, 17 and 19-20 are unpatentable under 35 U.S.C. § 102(e) by U.S. Patent No. 6,493,677 B1 to von Rosen *et al* (hereinafter "Rosen *et al*").

D. Whether claims 8 and 18 are unpatentable under 35 U.S.C. § 103(a) by Rosen *et al* in view of Official Notice.

None of the claims stand or fall together. The reasons why each claim is separately patentable are presented in the Arguments section below.

VII. ARGUMENTS

The rejections against the pending claims under consideration in the above-captioned patent application should be reversed for at least the reasons set forth below.

A. Brief Description of the Art Applied to the Claims

U.S. Patent No. 6,493,677 B1 to von Rosen *et al*

Rosen *et al* appears to be directed to a method and apparatus for creating and ordering customized branded merchandise over a computer network. The disclosure of Rosen *et al* appears to disclose allowing a customer to create and order customized branded merchandise.

The applied reference fails to show or obviate the combination of claim limitations, as recited by Appellant.

B. Summary of Argument

Claims 1-5, 7-15 and 17-20 are improperly rejected under 35 U.S.C. § 101 because the claimed inventions are directed to statutory subject matter.

Claims 1-5, 7-15 and 17-20 are improperly rejected under 35 U.S.C. § 112, first paragraph, because the specification complies with the written description requirement.

Claims 1-5, 7, 9-15, 17 and 19-20 are improperly rejected under 35 U.S.C. § 102(a) by Rosen *et al* because Rosen *et al* fails to show each and every claim limitation.

Claims 8 and 18 are improperly rejected under 35 U.S.C. § 103(a) by Rosen *et al* in view of Official Notice because the Office Action fails to set forth a *prima facie* case of obviousness. In particular, the combination of Rosen *et al* and Official Notice fails to show the claimed inventions.

C. The Claimed Inventions as Recited in Claims 1-5, 7-15, and 17-20 are Directed to Statutory Subject Matter

Claims 1-5, 7-15 and 17-20 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Appellant respectfully traverses and requests that the rejections be withdrawn.

The Examiner asserts that claims 1-5, 7-15 and 17-20 are directed to non-statutory subject matter. Specifically, the Examiner states that claims 1-5, 7-15 and 17-20 are not tied to the technological art. Office Action mailed October 13, 2004, page 8. Appellant respectfully submits that this is improper for at least the following reasons.

The Examiner has invoked 35 U.S.C. § 101. That section unequivocally states as follows (emphasis added):

§101 Inventions Patentable

> Whoever invents or discovers ***any new and useful process***, ***machine***, ***manufacture***, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Court of Appeals For The Federal Circuit has interpreted patentable subject matter to include subject matter that produces useful, concrete and tangible results. *See, e.g., AT&T Corp. v. Excel Communications*, 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999) (finding that a patent's claims to a method for enhancing a long-distance telephone call message record by adding a data field with information on the long-distance provider of the call recipient "fall comfortably within the broad scope of patentable subject matter under §101."); *State Street Bank Trust & Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998) (stating that mere fact that claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, would not, in and of itself, render invention non-statutory subject matter, unless its operation does not produce a useful, concrete and tangible result.).

The Office has the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Further, when such a rejection is made, the Office must expressly state how the language of the claims has been interpreted to support the rejection. In this case, any such showing is completely lacking. Thus, the Examiner has failed to make a *prima facie* showing.

Appellant respectfully submits that claims 1-5, 7-15 and 17-20 define inventions that produce "useful, concrete and tangible results" and, thus, satisfy the requirements of 35 U.S.C. § 101. For example, claims 1 and 11 recite a new and useful system and method for "configurating one or more products." According to one exemplary embodiment, the ***computer implemented system*** includes "***an online interface*** for receiving a request for a branded product from a user;" "***separating means for separating the product into at least an item, a process and an artwork*** wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified;" "***a pricing algorithm*** for assigning a price to the product wherein the price is based on the item, the process and the artwork *where a combination of the item parameters, process parameters and artwork parameters generates the price*;" "***linking means for linking the item parameters, the process parameters and the artwork parameters***;" "***creating means for creating a product identifier*** for the product;" and "branding means for branding the product as requested, wherein the product is identified by the product identifier." The ***computer implemented method*** also recites similar limitations. That such a process and system produce a useful, concrete and tangible result is unquestionable. For example, and as described in the Specification, one of the useful, concrete and tangible results of one embodiment of the invention is to provide the ability to link manufacturers, distributors and end-use corporations to the industry's complete e-marketplace. An embodiment of the present invention gives manufacturers and distributors the tools to sell more and spend less by taking advantage of the efficiency of e-commerce, while preserving the traditional methods of doing business. An embodiment of the present invention may use live data thereby making transactions more efficient, accurate and less complicated. An embodiment of the present

invention enables manufacturers and distributors to maintain and control the product prices displayed on their web sites as well as the prices seen by individual customers. In addition, manufacturers, distributors and other users may create custom web sites for individual markets and companies. (Specification, page 4, line 20 to page 5, line 7). Thus, the pending claims set forth useful inventions that have "real world" practical utility and that provide concrete, reproducible results that are tangible in the physical world. Furthermore, these results are obtained using the technological arts (*e.g.*, computer, online interface, algorithm, *etc.*) in a non-trivial manner. For at least these reasons, Appellant respectfully submits that the rejections under 35 U.S.C. § 101 are improper and requests that they be withdrawn.

In addition, at least two separate statutory categories of invention are recited in claims 1-5, 7-15 and 17-20. For example, claims 1-5 and 7-10 are directed to computer implemented methods, and claims 11-15 and 17-20 are directed to computer implemented systems. Each of these categories are explicitly recited in 35 U.S.C. § 101 as being patent eligible subject matter and the Examiner has not provided an explanation how any of the language, in any of the claims, for any of the categories is directed to an abstract idea.

The Examiner has improperly ignored the preamble reciting a "computer implemented" method and system. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See*, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14

USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar, however the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.).

D. Claims 1-5, 7-15 and 17-20 are improperly rejected under 35 U.S.C. § 112, first paragraph, because the specification complies with the written description requirement.

The Office Action alleges that claims 1-5, 7-15 and 17-20 fail to comply with the written description requirement. More specifically, the Office Action alleges that *a pricing algorithm for assigning a price to the product wherein the price is based on an item, a process and artwork where a combination of the item parameters, process parameters and artwork parameters generates the price* is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the invention. Office Action, mailed October 13, 2004, page 9. Further, the Office Action alleges that the specification does not teach assigning and generating a price for a product upon consideration of artwork parameters. Appellant respectfully disagrees.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Appellant contends that the pricing algorithm claim limitation is adequately disclosed in the specification as originally filed. The claims recite "*applying a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price.*"

The original specification on pages 6- 7 recite the following:

> Promotional products may include useful or decorative merchandise imprinted with an advertiser's identification, message or logo artwork. Various processes may be used to imprint artwork on a vast array of items and materials. Generally, promotional products may consist of two or more components, which may include an item (e.g., a mug) and a process (e.g., screen printing). *Other features or components may be specified.* A ***customer's artwork*** used in the imprint process may include specifications such as number of colors, imprint locations on the item, imprint sizes and other details. (Emphasis Added).

As supported by the original specification on page 8, lines 12-20, another feature of the present invention includes a pricing algorithm.

> The pricing algorithm may depend on the item and associated processes chosen. In general, the pricing may be based on the item and process production specifications. The manufacturing specifications for a particular promotional product may not exist *until an entity has specified item parameters, process parameters, a client's artwork parameters, and other specifications.* According to another feature of the present invention, manufacturers may go online and update their own pricing anytime so distributors may know that the price they see is the correct and most recent price. The present invention may assist the user in assessing an accurate cost with extra charges, such as setup charges, run charges, and even shipping charges.

In addition, Figures 11, 12a and 12b also illustrate an image upload feature as well as a customer's logo or artwork 1212 which is considered in the process of an embodiment of the present invention. Therefore, the highlighted excerpts identified above along with the rest of the original specification clearly provide the basis for the pricing algorithm limitation. An embodiment of the present invention may involve pricing based on item and process specification. In addition, another embodiment of the present invention may also involve artwork parameters, in addition to item parameters and process parameters. As supported by the specification, artwork parameters may include "number of colors, imprint locations on the item, imprint sizes and other details." (Specification, page 6-7). Therefore, Appellant respectfully submits that the written requirement has been satisfied, in accordance with 35 U.S.C. § 112, first paragraph.

E. Independent Claim 1 is Patentable Over Rosen *et al* under 35 U.S.C. 102(e)

According to one aspect of an embodiment of the present invention, claim 1 is directed to a computer implemented method for configurating one or more products. More specifically, independent claim 1 recites receiving a request for a branded product from a user through an online interface; separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork

parameters are identified; applying a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price; linking the item parameters, the process parameters and the artwork parameters; creating a product identifier for the product; and branding the product as requested, wherein the product is identified by the product identifier.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. In addition, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In this case, the Office Action has failed to show that Rosen *et al* discloses each and every claim limitation recited by Appellant. Therefore, the Office Action has failed to meet its burden. The rejection of independent claim 1 under 35 U.S.C. § 102(e) should be withdrawn and this claim and the dependent claims allowed accordingly.

For a proper rejection under 35 USC § 102(e), the Office Action must show each and every claim limitation disclosed in a single reference. The Office Action has completely failed to make a proper showing. The Rosen *et al* reference as applied by the Office Action fails to meet the combination of claim limitations set forth by Appellant. More specifically, the independent claims recite ***a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price***. These claimed features, among others, are completely missing in Rosen *et al.*

The Rosen *et al* reference appears to disclose a method and apparatus for creating and ordering customized branded merchandise over a computer network. The alleged "pricing" applied by Rosen *et al* does not involve at least the steps of "*separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified;*" "*applying* ***a pricing algorithm*** *for assigning a price to the product* ***wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price;***" and "***linking the item parameters, the process parameters and the artwork parameters;***" and "*creating* ***a product identifier*** *for the product.*" This combination of limitations is completely missing from the system of Rosen *et al.* In fact, the disclosure of Rosen *et al* provides no discussion of pricing features. The Office Action relies primarily on a basic traditional price quote on Fig. 9b and Fig. 11b. The Office Action also relies upon column 5, lines 35-54 which fails to mention any pricing features. Rosen *et al* is directed to creating and ordering customized branded merchandise but fails to provide any meaningful discussion of pricing functionality that relates in any way to the claimed pricing algorithm. Rather, Rosen *et al* merely shows a traditional static price quote.

According to an embodiment of the claimed invention, a pricing algorithm assigns a price to a product wherein a combination of item parameters, process parameters and artwork parameters generates the price. For example, a customer may desire to order a T-shirt with a company logo. According to an embodiment of the present invention, a product (e.g., T-shirt) indicates a product parameters, a process (e.g., embossing) is assigned a process parameter and artwork (e.g., colored logo) is assigned an artwork parameter. As the customer modifies the

various parameter, the corresponding price will be modified accordingly. For example, the customer may desire to modify the colored logo from two colors to four colors, which will affect the artwork parameter and the eventual price. Similarly, the customer may desire to modify the artwork to include a larger logo which will also affect the artwork parameter and the eventual price. These features and functions are not discussed nor even contemplated in the disclosure of Rosen *et al.* The Office Action merely relies a final price to meet the pricing algorithm claim limitation, without any consideration to the claimed features that determine the final price. Appellant contends that the price of Rosen *et al* fails to implement a pricing algorithm that assigns *a price to the product* ***wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price***. In contrast, Rosen's pricing method is not based on the claimed parameters.

There is no discussion of a pricing algorithm by Rosen et al as claimed by Appellant. Clearly, Rosen *et al* falls short of meeting the claimed limitations. Therefore, the applied reference in any combination fails to anticipate or obviate the claimed inventions. For at least these deficiencies, the rejections of the pending claims are improper and should be withdrawn.

F. Independent Claim 11 is Patentable Over Rosen *et al* under 35 U.S.C. 102(e)

Independent claim 11 recites a computer implemented system for configurating one or more products comprising an online interface for receiving a request for a branded product from a user; separating means for separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified; a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item

parameters, process parameters and artwork parameters generates the price; linking means for linking the item parameters, the process parameters and the artwork parameters; creating means for creating a product identifier for the product; and branding means for branding the product as requested, wherein the product is identified by the product identifier.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. In addition, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In this case, the Office Action has failed to show that Rosen *et al* discloses each and every claim limitation recited by Appellant. Therefore, the Office Action has failed to meet its burden. The rejection of independent claim 11 under 35 U.S.C. § 102(e) should be withdrawn and this claim and the dependent claims allowed accordingly.

For a proper rejection under 35 USC § 102(e), the Office Action must show each and every claim limitation disclosed in a single reference. As discussed above in connection with independent claim 1, the Office Action has completely failed to make a proper showing. The Rosen *et al* reference as applied by the Office Action fails to meet the combination of claim limitations set forth by Appellant. More specifically, the independent claims recite ***a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price.*** These claimed features, among others, are completely missing in Rosen *et al.*

G. Dependent Claims 8 and 18 are Patentable Over Rosen *et al* in view of Official Notice

With respect to claims 8 and 18, the Office Action relies upon Official Notice to address quantity break pricing parameters. The Office Action alleges that the concept and benefits of quantity break pricing information are notoriously old and well known in selling and buying transactions because a quantity break motivates the buyer to purchase more in quantity (page 8, Office Action mailed 4/28/04). Appellant respectfully traversed such a finding (page 8, Response to Office Action mailed 4/28/04). The identification of quantity break pricing information as process parameters, as recited by Appellant, is not well known and common in the art.

Despite Appellants traversal of the Examiner's Official Notice, the Examiner has refused to provide documentary evidence in the next Office action. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). Appellants contend that the traversal of Official Notice is adequate and proper. The Examiner has failed to show that quantity break pricing information is well known and old in the art, within the context of branded promotional products.

Claims 8 and 18 recite "*wherein the one or more process parameters comprise quantity break pricing information.*" The Office Action summarily concludes that it would have been obvious to modify Rosen to incorporate the concept of providing a quantity break pricing

information ... because a quantity price break will motivate the buyer to purchase more in quantity, as he saves money, and at the same time will benefit the seller for accruing increased revenue and also profits. (page 14, Office Action mailed October 13, 2004).

The modification of Rosen *et al* in view of Official Notice as applied to claims 8 and 18 is based purely on improper hindsight. The proposed rejections are classic examples of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) ("[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references."). Here, the Office Action modifies the Rosen *et al* reference to allegedly yield dependent claims 8 and 18. The Office Action has failed to set forth a *prima facie* case of obviousness for these dependent claims.

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office Action set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for modifying the Rosen *et al* reference has absolutely nothing to do with the deficiencies of Rosen *et al.* To properly modify Rosen *et al* to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with the Rosen *et al* system. Any such motivation is completely lacking.

The Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to modify the Rosen *et al* reference as suggested by the Office Action. The mere fact that the various separate disclosures and teachings can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01*; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "'[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests

to one of ordinary skill in the art'" (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

H. Dependent claims 2-5, 7-10, 12-15 and 17-20 are Each Separately Patentable over Rosen *et al*

The remaining claims depend ultimately from independent claims 1 and 11 and, as such, contain the features recited in claims 1 and 11. As discussed above, the proposed combinations fail to suggest or disclose each feature recited in claims 1 and 11 and, therefore, also fails to suggest or disclose at least these same features in the dependent claims. For at least this reason, Appellant respectfully submits that the rejections of the pending claims are improper and request that they be withdrawn. Additionally, these claims are separately patentable over the proposed combination of references for at least the reasons stated below.

1. Claim 2 is Separately Patentable

Claim 2 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the step of separating the product further comprises the step of supplying an item template*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 2. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

2. Claim 3 is Separately Patentable

Claim 3 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the step of separating the product further comprises the step of supplying a process template*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of

claim 3. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

3. Claim 4 is Separately Patentable

Claim 4 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the step of separating the product further comprises the step of creating an item definition page based on the item template.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 4. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

4. Claim 5 is Separately Patentable

Claim 5 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the step of separating the product further comprises the step of creating a process definition page based on the process template.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 5. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

5. Claim 7 is Separately Patentable

Claim 7 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the one or more item parameters comprise description information.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 7. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

6. Claim 9 is Separately Patentable

Claim 9 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the one or more process parameters comprise pricing information.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 9. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

7. Claim 10 is Separately Patentable

Claim 10 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the step of creating a product identifier comprises dynamically creating the product identifier when the product is sourced, quoted or ordered.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The Rosen *et al* reference fails to show each and every limitation of claim 10. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

8. Claim 12 is Separately Patentable

Claim 12 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the separating means for separating the product further comprises means for supplying an item template.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 12. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

9. Claim 13 is Separately Patentable

Claim 13 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the separating means for separating the product further comprises means for supplying a process template.* The Office Action's rejection of this claim is improper for the reasons set

forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 13. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

10. Claim 14 is Separately Patentable

Claim 14 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the separating means for separating the product further comprises means for creating an item definition page based on the item template.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 14. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

11. Claim 15 is Separately Patentable

Claim 15 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the separating means for separating the product further comprises means for creating a process definition page based on the process template.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 15. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

12. Claim 17 is Separately Patentable

Claim 17 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the one or more item parameters comprise description information.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 17. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

13. Claim 19 is Separately Patentable

Claim 19 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the one or more process parameters comprise pricing information.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 19. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

14. Claim 20 is Separately Patentable

Claim 20 is separately patentable because the Rosen *et al* reference fails to disclose *wherein the creating means for creating a product identifier comprises dynamically creating the product identifier when the product is sourced, quoted or ordered.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 11. The Rosen *et al* reference fails to show each and every limitation of claim 20. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

VIII. CONCLUSION

In view of the foregoing, Appellant respectfully request that the Board reverse the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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APPENDIX A - PENDING CLAIMS

CLAIMS

1. **(Previously Presented)** A computer implemented method for configurating one or more products, the computer implemented method comprising the steps of:

receiving a request for a branded product from a user through an online interface;

separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified;

applying a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price;

linking the item parameters, the process parameters and the artwork parameters;

creating a product identifier for the product; and

branding the product as requested, wherein the product is identified by the product identifier.

2. **(Original)** The method of claim 1 wherein the step of separating the product further comprises the step of supplying an item template.

3. **(Original)** The method of claim 1 wherein the step of separating the product further comprises the step of supplying a process template.

4. **(Original)** The method of claim 2 wherein the step of separating the product further comprises the step of creating an item definition page based on the item template.

5. **(Original)** The method of claim 3 wherein the step of separating the product further comprises the step of creating a process definition page based on the process template.

6. **(Canceled)**

7. **(Previously Presented)** The method of claim 1 wherein the one or more item parameters comprise description information.

8. **(Previously Presented)** The method of claim 1 wherein the one or more process parameters comprise quantity break pricing information.

9. **(Previously Presented)** The method of claim 1 wherein the one or more process parameters comprise pricing information.

10. **(Original)** The method of claim 1 wherein the step of creating a product identifier comprises dynamically creating the product identifier when the product is sourced, quoted or ordered.

11. **(Previously Presented)** A computer implemented system for configurating one or more products, the computer implemented system comprising:

an online interface for receiving a request for a branded product from a user;

separating means for separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified;

a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price;

linking means for linking the item parameters, the process parameters and the artwork parameters;

creating means for creating a product identifier for the product; and

branding means for branding the product as requested, wherein the product is identified by the product identifier.

12. **(Original)** The system of claim 11 wherein the separating means for separating the product further comprises means for supplying an item template.

13. **(Original)** The system of claim 11 wherein the separating means for separating the product further comprises means for supplying a process template.

14. **(Original)** The system of claim 12 wherein the separating means for separating the product further comprises means for creating an item definition page based on the item template.

15. **(Original)** The system of claim 13 wherein the separating means for separating the product further comprises means for creating a process definition page based on the process template.

16. **(Canceled)**

17. **(Previously Presented)** The system of claim 11 wherein the one or more item parameters comprise description information.

18. **(Previously Presented)** The system of claim 11 wherein the one or more process parameters comprise quantity break pricing information.

19. **(Previously Presented)** The system of claim 11 wherein the one or more process parameters comprise pricing information.

20. **(Original)** The system of claim 11 wherein the creating means for creating a product identifier comprises dynamically creating the product identifier when the product is sourced, quoted or ordered.

APPENDIX B - EVIDENCE

None

APPENDIX C - RELATED PROCEEDINGS

No decisions have been rendered by a court of the Board in any proceeding identified pursuant to paragraph II.